

REMARKS

The final Office Action May 5, 2004 was received and carefully reviewed. Accordingly, the Applicant requests reconsideration of this application in light of the remarks to follow.

Initially, the Applicant wishes to thank the Examiner for indicating consideration of the IDS filed on July 20, 2000.

With regard to the rejections of:

Claims 2, 3, 5, 6, 8-10, 12, 13, 15-17, 19, 20 and 22, under 35 U.S.C. §103(a), as being obvious in view of the combination of teachings of Cunningham et al. ('842), Zhang ('027) and Zhang et al. ('947), and

Claims 4, 7, 11, 14, 18 and 21, under 35 U.S.C. §103(a), as being obvious in view of the combination of teachings of Cunningham et al. ('842), Zhang ('027), Zhang ('947) and Nomoto et al. ('364),

each of these new grounds of rejection is respectfully traversed.

As the Examiner is aware, Pubic Law106-113, section 1000(a)(9), 113 Stat. 1501A-591, amended 35 U.S.C. 103 at paragraph (c), to state:

35 U.S.C. 103. Conditions for patentability; non-obvioussubject matter.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Further, as pointed out in MPEP Chapter 706.02(1)(1):

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues...The mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application. (Emphasis added)

While MPEP Chapter 906.02(1)(2)(II) notes that:

Applications and references...will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assign to, the same person.

Accordingly, since the instant application was filed on July 20, 2000 as a continuing divisional application of U.S. Application No. 08/857,556, filed May 16, 1997, which is a divisional of U.S. Application No. 08/250,344, filed May 27, 1994, which is a continuation of U.S. Application No. 08/041,520, filed March 30, 1993 which is a continuation of U.S. Application No. 07/729,533 ('533), filed July 5, 1991 and since the '533 Application was properly assigned (copy attached) Semiconductor Energy Laboratory Co., Ltd. the following statement is hereby made:

U.S. Application No. 09/620,968, U.S. Patent 6,607,947 and U.S. Patent Application Publication 2003/0060027 (U.S. Application No. 10/289,313) were, at the time the invention of U.S. Application 09/620,968 was made, owned by Semiconductor Energy Laboratory Co., Ltd.

This clear and conspicuous statement is believed sufficient to remove the Zhang ('027) and Zhang et al. ('947) as prior art in the rejections under § 103 of record.

Consequently, since neither the Cunningham et al. or Nomoto et al. references set forth any teachings about forming a silicon nitride by sputter deposition in an atmosphere comprising nitrogen, let alone nitrogen at 75 volume% or more as presently claimed, each of the rejections of record are now improper. That is, a *prima facie* case of obviousness of claims 2-22 has not been set forth by either of the §103(a) rejections of record. Accordingly, the Applicant respectfully requests withdrawal of each of those rejections.

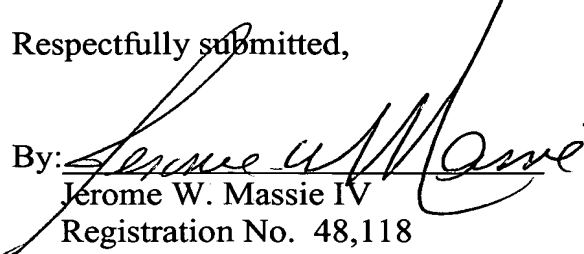
While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Lastly, it is noted that a separate Extension of Time Petition (one month) accompanies this response along with an authorization to charge the requisite extension of time fee to Deposit Account No. 19-2380 (740756-2183). However, should that petition become separated from this Amendment, then this Amendment should be construed as containing such a petition. Likewise, any

overage or shortage in the required payment should be applied to Deposit Account No. 19-2380 (740756-2183).

Respectfully submitted,

By:


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0756-594
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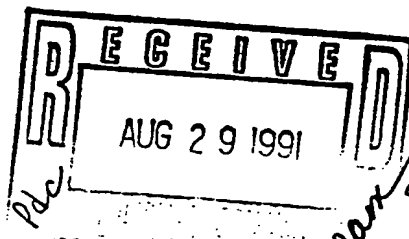
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FILING DATE 07/15/91

PATENT PATENT

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Attorney Docket No. 0756-594 (756-346)

ASSIGNMENT OF PATENT APPLICATION OR PATENT

Shunpei YAMAZAKI

TO

Semiconductor Energy
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July 15, 1991

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WHEREAS, Shunpei YAMAZAKI

Insert Name(s)
of Inventor(s)

Insert Title of
Invention

(hereinafter designated as the undersigned) has (have) invented certain new and useful improvements in _____

Method of Forming Insulating Films, Capacitances, and
Semiconductor Devices

Insert Date of
Signing of
Application

for which an application for Letters Patent of the United States of America has been executed by the undersigned on _____; and

Insert Name of
Assignee

WHEREAS, Semiconductor Energy Laboratory Co., Ltd.

Insert Address
of Assignee

of 398, Hase, Atsugi-shi, Kanagawa-ken, 243 Japan

its heirs, successors, legal representatives and assigns (hereinafter designated as the Assignee) is desirous of acquiring the entire right, title and interest in and to said invention and in and to any Letters Patent(s) that may be granted therefor in the United States of America;

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to the undersigned in hand paid, the receipt of which is hereby acknowledged, and other good and valuable consideration, the undersigned has (have) sold, assigned and transferred, and by these presents do sell, assign and transfer unto said Assignee the full and exclusive right to the said invention in the United States of America and its territories, dependencies and possessions and the entire right, title and interest in and to any and all Letters Patent(s) which may be granted therefor in the United States of America and its territories, dependencies and possessions, and in and to any and all divisions, reissues, continuations and extensions thereof for the full term or terms for which the same may be granted.

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The undersigned agree(s) to execute all papers necessary in connection with this application and any continuing, divisional or reissue applications thereof and also to execute separate assignments in connection with such applications as the Assignee may deem necessary or expedient.

The undersigned agree(s) to execute all papers necessary in connection with any interference which may be declared concerning this application or any continuation, division or reissue thereof or Letters Patent(s) or reissue patent issued thereon and to cooperate with the Assignee in every way possible in obtaining and producing evidence and proceeding with such interference.

The undersigned agree(s) to execute all papers and documents and to perform any act which may be necessary in connection with claims under or provisions of the International Convention for the Protection of Industrial Property or similar agreements.

The undersigned agree(s) to perform all affirmative acts which may be necessary to obtain a grant of a valid United States patent(s) to the Assignee and to vest all rights therein hereby conveyed to said Assignee as fully and entirely as the same would have been held by the undersigned if this Assignment and sale had not been made.

The undersigned hereby authorize(s) and request(s) the Commissioner of Patents and Trademarks to issue any and all Letters Patents of the United States of America resulting from said application or any division or divisions or continuing or reissue applications thereof to the said Assignee, as Assignee of the entire interest, and hereby covenants that he has (they have) the full right to convey the entire interest herein assigned, and that he has (they have) not executed, and will not execute, any agreement in conflict herewith.

The undersigned hereby grant(s) the law firm of Sixbey, Friedman, Leedom & Ferguson, P.C. the power to insert on this Assignment any further identification which may be necessary or desirable in order to comply with the rules of the U.S. Patent and Trademark Office for recordation of this document.

In witness whereof, this Assignment has been executed by the undersigned on the date(s) opposite the undersigned name(s).

Date 7/9/1991, Name of Inventor Shaygi, Zayhi (SEAL)
(signature)
Date _____, Name of Inventor _____ (SEAL)
(signature)
Date _____, Name of Inventor _____ (SEAL)
(signature)
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(This assignment should preferably be acknowledged before a United States Consul or Notary Public. If not, then the execution by the Inventor(s) should be witnessed by at least two other persons who should sign here.)

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